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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 26

Application Number: 08/781,696
Filing Date: January 10, 1997
Appellant(s): BANATWALA ET AL.

MAILED

JAN 1 3 2003

Technology Center 2100

C. Steven Kurlowecz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/29/2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(4) *Status of Amendments*

The Appellant's statement of the status of amendments contained in the brief is correct.

(5) *Summary of the Invention*

The summary of the invention in the brief is correct.

(6) *Issues*

The Appellant's statement of the issues contained in the brief are correct.

(7) *Grouping of the Claims*

The following groups of claims stand or fall together: (1, 7, and 12), (1, and 2), (12, and 16-17), (3, 8, and 13), (4, 9, and 14), (5, 10, and 15), (6, and 11).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

Windows NT Explorer 4.0 screen dumps (Figs. 1-9, 1994).

PhotoImpact 3.0 file dialog boxes screendumps, hereinafter Photoimpact (1996)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

- A. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- B. Claims 1-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Windows NT Explorer 4.0 screen dumps (Figs. 1-9, 1994), in view of PhotoImpact 3.0 file dialog boxes screendumps, hereinafter Photoimpact (1996).

Regarding independent claims 1, and 7, Windows NT Explorer discloses the invention as follows:

It is noted that Windows NT Explorer disclose a *file/image previewing apparatus*—
Windows NT Explorer Quick View program.

Moreover, Windows NT Explorer discloses *an extension...the extension sharing a user interface with the operating system...enabling display of internal file characteristics and the file image of the desired file by opening the desired file in a manner free of opening an application*

program in working memory..... (Quick View pop-up window in Fig. 2, and pop-up window in fig.6-7, which shares an interface with windows os, enables user to open, and display the internal contents of a file, e.g., color type, graphics, font etc, and the file image without opening an application program in the computer's memory). Windows NT Explorer fails to explicitly disclose: *an extension...enabling display of a recitation of indicia of internal file characteristics separate from the file image*. Photoimpact teaches the display of file characteristics—color type, compression, image dimensions, number of pixels..etc—separate from the image(p.1-2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Windows NT Explorer, and Photoimpact, because Windows NT Explorer teaches above the flexibility of file management features, moving, copying, the display of detailed file characteristics without the time-consuming task of opening an application program in working memory, etc not afforded in most application programs.

Furthermore, Windows NT Explorer discloses *display assembly for displaying the recitation of indicia of file characteristics in a manner free of opening a application program in working memory* (preview of file in Fig. 3, and pop-up window in fig.6-7, which shows the internal contents of a file, e.g., color type, graphics, font etc, and the file image without opening an application program in the computer's memory). Windows NT Explorer fails to explicitly disclose: *displaying the recitation of indicia of internal file characteristics separate from the file image*. Photoimpact teaches the display of file characteristics—color type, compression, image dimensions, number of pixels..etc—apart from the image (p.1-2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Windows NT Explorer, and Photoimpact, because Windows NT Explorer teaches above the

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flexibility of file management features, moving, copying, the display of detailed file characteristics without the time-consuming task of opening an application program in working memory, etc not afforded in most application programs.

Regarding dependent claim 2, Windows NT Explorer discloses:

an extension coupled to the file manager....user interface in common with the file manager....

(pop-up window in Fig. 2).

Regarding dependent claims 3, Windows NT Explorer discloses:

an extension....display of working image from the file (i.e selection of file Dffintro and its display in Figs. 2 and 3).

Regarding dependent claims 4, Windows NT Explorer discloses:

a display of the working image is a reduced-in-size version of working image(Fig. 3).

Claim 5 is directed towards an apparatus for implementing the system found in claim 1, and is therefore similarly rejected.

Regarding dependent claims 6, Windows NT Explorer discloses that:

the file manager is a document manager for managing folders of files (Fig. 9);

and *the extension* (pop-up windows in Fig. 9, from the “New” option in the “File” menu, would enable the user to create, delete, rename, etc folders) *enables display of folder characteristics...*

(Fig. 9). It is noted that Windows NT Explorer fails to explicitly disclose a single *characteristic* as referred to in claim 6, however, it would have been obvious to a person of ordinary skill in the art at the time of the invention to enable *the extension* to display one *folder characteristic*, instead of several *characteristics* as in claim 11 and Windows NT in order to customize the display.

Regarding dependent claim 8, Windows NT Explorer discloses:
an extension....display of working image from the file (i.e selection of file Dffintro and its display in Figs. 2 and 3).

Regarding dependent claim 9, Windows NT Explorer discloses:
a display of the working image is a reduced-in-size version of working image(Fig. 3).

Regarding dependent claim 10, Windows NT Explorer discloses:
method and apparatus to provide *the indication of file characteristics* (the compression type of Winzip file “4, 8-5, 5, 99” at the bottom of Fig. 8). It is noted that Windows NT Explorer fails to explicitly disclose the *annotation graphics of the file*, however, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include these *annotation graphics* along with at least one of *the file characteristics*, such as compression type in order to have specific details on the file or image.

Regarding dependent claim 11, Windows NT Explorer discloses that:
the file manager is a document manager for managing folders of files (Fig. 9);
and *the extension* (pop-up windows in Fig. 9, from the “New” option in the “File” menu, would enable the user to create, delete, rename, etc folders) *enables display of folder characteristics...* (Fig. 9). It is noted that Windows NT Explorer fails to explicitly disclose a single *characteristic* as referred to in claim 6, however, it would have been obvious to a person of ordinary skill in the art at the time of the invention to enable *the extension* to display one *folder characteristic*, instead of several *characteristics* as in claim 11 and Windows NT in order to customize the display.

Regarding independent claims 12, Windows NT Explorer discloses the invention as follows:

It is noted that Windows NT Explorer discloses *providing a working memory for executing application programs, and executing application programs in said working memory*...—Windows NT Explorer “about Quick View” window in fig. 4 teaches memory for the execution of application programs.

It is noted that Windows NT Explorer discloses a *file/image previewing apparatus*—Windows NT Explorer Quick View program.

Moreover, the limitations of *enabling display of internal file characteristics....and in a manner free of opening and running an application program in working memory*, are rejected based on the same basis as claim 1.

Claim 13 is directed towards a method for implementing the system found in claim 1, and is therefore similarly rejected.

Regarding dependent claims 14, Windows NT Explorer discloses:
a display of the working image is a reduced-in-size version of working image (Fig. 3).

Regarding dependent claims 15, Windows NT Explorer discloses:
method and apparatus to provide *the indication of file characteristics* (the compression type in Fig. 7).

It is noted that Windows NT Explorer fails to explicitly disclose the *annotation graphics of the file*, however, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include these *annotation graphics* along with at least one of *the file*

characteristics, such as compression type in order to have a more complete and specific details on the file or image.

Claim 16 is directed towards a method for implementing the system found in claim 1, and is therefore similarly rejected.

Regarding dependent claim 17, Windows NT Explorer discloses the invention as follows:
a method....step of providing operating system means (Windows NT Explorer in Fig. 1) includes at least one of: providing a document manager..... (left pane in Fig. 5) and providing a file manager (right pane in Fig. 1)..... in a manner free of opening an application program in the working memory.

(11) Response to Argument

In response to appellants' argument that there is no suggestion to combine the references (p.5,L.14-17), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The Examiner disagrees, because **Explorer** teaches the obtaining file characteristics or properties without opening a separate application program in working memory, through a software extension to the Windows operating system--Quickview (fig.6-7). Windows NT Explorer fails to explicitly disclose: *displaying the recitation of indicia of internal file characteristics separate from the file image*. However, **Photoimpact** teaches the display of

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image file characteristics—color type, compression, image dimensions, number of pixels..etc—
apart from opening the image (p.1-2). It would have been clearly obvious to a person of
ordinary skill in the art at the time of the invention to combine the teachings of Windows NT
Explorer, and Photoimpact, because Windows NT Explorer teaches above the flexibility of file
management features, moving, copying, the display of detailed file characteristics without the
time-consuming task of opening an application program in working memory, etc not afforded in
most application programs, and to display additional file characteristics as taught above by
Photoimpact.

Regarding Appellants' contention that Explorer and Photoimpact do not even recognize
the difference that exist between an operating system, nor an interfacing mechanism (p.5,L.18-
24). The Examiner disagrees, because Explorer teaches the retrieval of file characteristics
without the aid of an application program opened in the memory of the computer system (fig. 1-
7). Photoimpact teaches the fetching of file characteristics without having to obtain those
characteristics from the images themselves (p.1-2). One has to remember that the files accessed
by Photoimpact are stored and managed by an operating system, Windows NT in this case, so
that Photoimpact has to interact with the operating system to access the files in such operating
system.

Moreover, the Examiner disagrees with Appellants' argument that Photoimpact is an
application program not affiliated with the operating system (p.6,L.3-5). Photoimpact has to be
affiliated with the operating system it runs under. Photoimpact, just as any application program
running under an operating system, needs interaction with the operating system in order to

operate within a given computer system, because the application programs need the operating system to function at all, and/or communicate with the computer system.

Moreover, the Examiner disagrees with Appellants' argument that Photoimpact does not teach a motivation to be modified as an operating system extension (p.6, L.9-16). In this case, it is Explorer what's being modified to incorporate some of the features found in Photoimpact, not the entire application. The extraction of file characteristics, as those extracted in Photoimpact(p.1-2), in addition to file characteristics-retrieving capabilities of Explorer is what's being incorporated into Explorer from Photoimpact, not the incorporation of the entire Photoimpact application as suggested by the Appellants.

Claims 7, and 12 are rejected at least based on the explanations set forth above herein.

In addition, the Appellants contend that there is a lack of reasonable expectation of success in the combination of Explorer, and Photoimpact (p.7,L.7-14). The Examiner disagrees, because as stated above, that it is Explorer what's being modified to incorporate some of the features found in Photoimpact, not the entire Photoimpact application.

Moreover, the Appellants state that the Examiner stated that Photoimpact is not affiliated with the operating system (p.8,L.22-27). While it is true that Photoimpact is an application program, not affiliated with or part of the operating system, it nevertheless runs on, and relies on the operating system for communications and interaction with the computer system, for the retrieval of files among other functions. This establishes a difference between the operating system extension and application program. Once again, the combination of Explorer, and Photoimpact is to incorporate the retrieval, and display of file characteristics as taught by

Explorer (fig.1), and the retrieval of file characteristics, which is done without opening an image, as taught by Photoimpact (file information description in the open dialog box of p.1, and p.2).

In addition, the Appellants contend that the use of screendumps is questionable since it lacks a narration, and is open to various interpretations (p.8,L.3-10). The Examiner disagrees, because the Explorer screendumps clearly teach, an extension or part of the Windows NT operating system—Explorer interface(s) as a unit—for retrieving file characteristics, file name, size, type, etc. (fig.1-7).

Further, the Appellants add that Helen Custer discloses that Windows NT “does not open an application program to provide file previewing features” (p.8,L.14-15). The Appellants are in agreement with the Examiner, because this is what has been explained by the Examiner in the rejection of claims 1, and 7 above—“ Moreover, Windows NT Explorer discloses *an extension...the extension sharing a user interface with the operating system...enabling display of internal file characteristics and the file image of the desired file by opening the desired file in a manner free of opening an application program in working memory”* --end of page 3, and page 4 .

The Appellants indicates that the combination of Explorer, and Photoimpact suggests that Explorer opens and runs Photoimpact to display internal file characteristics (p.8,L.21-24, p.9,L.1-14). As the Examiner has been explaining above, the combination of the retrieval of file characteristics by Explorer, and the retrieval of extra file characteristics by Photoimpact without opening a file, does not yield the running of Photoimpact from Explorer interface. Rather, one of ordinary skill in the art at the time of the invention would be motivated to combine the additional file descriptions taught by Photoimpact, with the file characteristics retrieval of

Explorer without opening an application program, so as to provide a fuller and more complete file description to an user. Therefore, it is evident that this combination would have plenty of success in the display of additional file properties to a user.

Furthermore, the Appellants indicates that “Nowhere does QuickView display an indicia of internal file characteristics, such as height values, width values, length values, ...”p.10,L.1-20. Windows NT Explorer discloses *an extension...the extension sharing a user interface with the operating system...enabling display of internal file characteristics and the file image of the desired file by opening the desired file in a manner free of opening an application program in working memory... ..* (Quick View pop-up window in Fig. 2, and pop-up window in fig.6-7, which shares an interface with windows os, enables user to open, and display the internal contents of a file, e.g., color type, graphics, font etc, and the file image without opening an application program in the computer’s memory). Windows NT Explorer fails to explicitly disclose: *an extension...enabling display of a recitation of indicia of internal file characteristics separate from the file image*. Photoimpact teaches the display of file characteristics—color type, compression, image dimensions, number of pixels..etc—separate from the image(p.1-2). As has been established in the rejections, and response above, Explorer and Photoimpact teach all the limitations of the claims.

Conclusion

For all of the reasons stated above the Examiner believes that the rejections should be sustained.

Respectfully submitted,

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January 9, 2003

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